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10/766,247	01/28/2004	James Roach	INT856/4-001US	4164

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EXAMINER

DINH, KHANH Q

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/766,247	Applicant(s) ROACH, JAMES	
	Examiner Khanh Dinh	Art Unit 2151	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.  
     4a) Of the above claim(s) 14-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 41-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-60 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/30/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-60 are presented for examination.

**Election/Restriction**

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 41-60, drawn to a method of remotely collection of data in a network, classified in class 709, subclass 224.
  - II. Claims 14-26, drawn to a method and system for comparing and updating previously collected set of data, classified in class 709, subclass 218.
  - III. Claims 27-40, drawn to a method of proving access to a dealer data stored in a dealer management system, classified in class 709, subclass 226.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I, II, III are related as subcombinations disclosed as usable together in a combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as to a method a method of remotely collection of data in a network, classified in a *different Class/Subclass*. Invention II has separate utility such as a method and system for comparing and updating previously collected set of data, classified in a *different Class/Subclass*. Invention III has separate utility such as a method of proving access

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to a dealer data stored in a dealer management system, classified in a *different Class/Subclass*.

4. The inventions are distinct, each from the other, because of the following reasons:

(a) These inventions have acquired a separate status in the art as shown by their different classifications.

(b) The search required for each Group is different and not co-extensive for examination purposes.

For example, the searches for the three inventions would not be co-extensive because these Groups would require different searches on PTO's classification class and subclass as following:

the Group I search (claims 1-13 and 41-60) would require use of search **class 709, subclass 224** (not require for the inventions II, III).

the Group II search (claims 14-26) would require use of search **class 709, subclass 218** (not require for the inventions I, III).

the Group III search (claims 27-40) would require use of search **class 709, subclass 226** (not require for the inventions I, II).

For the reasons given above restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Engel Barry (the Undersigned Attorney) on 10/26/2005 a provisional election was made without traverse to prosecute the invention of Group 1, claims 1-13 and 41-60. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14-40 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Therefore, claims *1-13 and 41-60* are presented for examination.

### ***Specification***

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is advised that they are responsible for the entire content and relevant passages other than those cited by the Examiner should be addressed accordingly.

#### **Claim Rejections - 35 USC § 112**

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention. The term "substantially" in claims 8, 47 and 58 is relative term which render the claims indefinite. The term "substantially" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

#### **Claim Rejections - 35 USC § 102**

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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11. Claims 1-12 and 41-52 and 54-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrod et al., US pat. No.6,405,049 (hereafter Herrod).

As to claim 1, Herrod discloses a method for remotely collecting data from a dealer management system (12 fig.2a), comprising:

identifying a dealer management system (12 fig.2a) that is coupled to a secure data access port, wherein the secure data access port is also coupled to a public network (internet/Intranet 15 fig.2a), and the dealer management system is coupled to at least one client device (10 fig.2a) and is operable to process dealer initiated transactions from the client device (processing and downloading data information to a portable device, see abstract, figs. 1, 2a, col.5 line 33 to col.6 line 48);

remotely connecting to the dealer management system from a remote system (host system) using the public network, wherein the remote connection is a public connection established through the secure data access port, and the secure data access port is operable to pass remote transactions received from the remote system to the dealer management system (see col.7 lines 1-38 and col.8 lines 21-65);

forwarding a remote transaction from the remote system to the dealer management system, wherein the remote transaction includes a request for stored data and is given a priority level by the dealer management system that is similar to client initiated transactions (using customer's buying preferences and patterns, see col.9 lines 3-48 and col.11 lines 3-51); and

receiving at the remote system the requested data from the dealer management system (see col.11 lines 20-67).

As to claim 2, Herrod discloses wherein remotely connecting to the dealer management system from a remote system using the public network comprises remotely connecting to the dealer management system using the Internet (see col.5 lines 33-65).

As to claim 3, Herrod discloses wherein the secure data access port is assigned an IP address, and the remote system connects to the dealer management system using the Internet by entering the IP address of the secure data access port (see col.28 lines 35-65).

As to claim 4, Herrod discloses wherein the secure data access port including a security module that is operable to execute a security protocol that restricts access to the secure data access port wherein the security protocol includes: when initiating the remote connection with the secure data access port (using file access card, see col.27 lines 12-58), providing a private key that corresponds to a public key previously associated with the secure data access port if the private key corresponds with the public key, the remote system is granted access to the secure data access port otherwise remote access is denied (see col.28 lines 14-65).

As to claim 5, Herrod discloses the secure data access port includes a security module that is operable to execute a security protocol that restricts access to the secure data



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access port wherein the security protocol including when initiating the remote connection with the secure data access port providing an IP address of the remote system to the secure data access port, wherein the secure data access port is operable to determine if the IP address is an accepted IP address, and if the IP address is determined to be an accepted IP address, the remote system is granted access to the secure data access port, otherwise remote access is denied (see fig.21 and col.27 line 12 to col.28 line 65 and col.29 lines 17-65).

As to claim 6, Herrod discloses the secure data access port includes a security module that is operable to execute a security protocol that restricts access to the secure data access port, wherein the security protocol includes: when initiating the remote connection with secure data access port, providing a pass-code to the secure data access port and if the pass-code is determined to be a valid pass-code, the remote system is granted access to the secure data access port, otherwise remote access is denied (see fig.21 and col.27 line 12 to col.28 line 65 and col.29 lines 17-65).

As to claim 7, Herrod discloses logging on to the dealer management system by providing a pass-code, wherein the pass-code provides file level access to certain data stored in the dealer management system and the remote transaction includes a command to directly access data from the dealer management system (see fig.21 and col.27 line 12 to col.28 line 65 and col.col.29 lines 17-65).

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As to claim 8, Herrod discloses in the secure data access port transforming the remote transaction into a format that is acceptable for processing by the dealer management system, wherein the transformed transaction is in substantially the same format as client initiated transactions and in the secure data access port, transforming the requested data received from the dealer management system into a format acceptable for transmission over the public network (see fig.33a, col.9 line 13 to col.10 line 44 and col.16 lines 2-52).

As to claim 9, Herrod discloses the requested data received from the dealer management system is transformed into data packets acceptable for transmission to the remote system using the TCP/IP protocol in an encrypted format (see col.30 line 30 to col.31 line 48).

As to claim 10, Herrod discloses the remote transaction received from the remote system is transformed into a serial data stream acceptable for transmission to the dealer management system (see fig.33a, col.9 line 13 to col.10 line 44 and col.31 lines 3-65).

As to claim 11, Herrod discloses remotely connecting to the dealer management system from a remote system using the public network comprises remotely connecting to the dealer management system using an indirect connection that includes at least one

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intermediary device logically positioned between the remote system and the secure data access port (see fig.33a, col.9 line 13 to col.10 line 44 and col.16 lines 2-52).

As to claim 12, Herrod discloses wherein the secure data access port includes a board level computer, and the board level computer is operable to allow the remote system to remotely configure the secure data access port (see fig.33a, col.9 line 13 to col.10 line 44 and col.35 line 40 to col.36 line 59).

As to claims 41 and 51, Herrod discloses a system to facilitate the remote collection of data, comprising:

a secure data access port coupled to a public network and a dealer management system (12 fig.2a), wherein the dealer management system includes at least one client device (10 fig.2a) and is operable to process dealer initiated transactions from the client device (processing and downloading data information to a portable device, see abstract, figs. 1, 2a, col.5 line 33 to col.6 line 48), wherein the secure data access port is cooperatively operable with the dealer management system to:

accept a remote connection from a remote system, wherein the remote connection is a public connection established with the secure data access port, and the secure data access port is operable to pass remote transactions received from the remote system to the dealer management system (see col.7 lines 1-38 and col.8 lines 21-65);

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receive a remote transaction from the remote system and forward the remote transaction to the dealer management system, wherein the remote transaction includes a request for stored data and is given a priority level by the dealer management system that is similar to client initiated transactions and forward the requested data received from the dealer management system to the remote system (using customer's buying preferences and patterns for processing data information, see col.9 lines 3-48 and col.11 lines 3-51).

Claims 42-49 are rejected for the same reasons set forth in claims 12, 3, 4, 5, 6 and 8-10 respectively.

As to claim 50, Herrod discloses the secure data access port is coupled to a client device and the secure data access port is operable to provide pass-through connectivity to the dealer management system for the client device, and the pass-through connectivity occurs transparent to the client device (see fig.2b, col.10 lines 15-58 and col.12 lines 1-42).

Claims 52 and 54-60 are rejected for the same reasons set forth in claims 12, 3-6 and 8-10 respectively.

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***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 13 and 53 rejected under 35 U.S.C. 103(a) as being unpatentable over Herrod in view of Reiner, US pat. No.6,219,676 (hereafter Reiner).

As to claims 13 and 53, Herrod's teachings still applied as in claims 1 and 51 above.

Herrod does not specifically disclose identifying an automobile dealership's dealer management system. However, Reiner discloses identifying an automobile dealership's dealer management system (see abstract, fig.1, col.5 line 20 to col.6 line 51). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Reiner's teachings into the computer system of Herrod to process client activities on the Internet because it would have handled a variety of client requests through the web server and provided more utilizations of the computer system on the Internet communications network.

***Other prior art cited***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Herrod et al, US pub. No.2001/0055978.

b. Teppler, US pat. No.6,898,709.

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c. Maddalozzo Jr. et al, US pat. No.5,878,218.

***Conclusion***

15. Claims 1-13 and 41-60 are rejected.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Khanh Dinh  
Primary Examiner  
Art Unit 2151  
1/17/2006